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PATENT
02931-P0023A WWW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---------------------------|-------------------------------|
| Inventors | Karl Storz <i>et al.</i> |
| U.S. Patent No. 6,042,593 | Issue Date: March 28, 2000 |
| Title of Patent: | Shaving Or Cutting Instrument |

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SEP 1 9 2004
LICENSING & REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR RETROACTIVE FOREIGN
FILING LICENSE PURSUANT TO 37 C.F.R. 5.25**

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SEP 02 2004

OFFICE OF PETITIONS

Dear Sir:

Patentee, through its undersigned attorneys, hereby petitions under 37 C.F.R. 5.25 for issuance of a retroactive foreign filing license. Through error and without deceptive intent, the subject matter of the above-captioned patent was foreign filed before issuance of a foreign filing license by the United States Patent and Trademark Office.

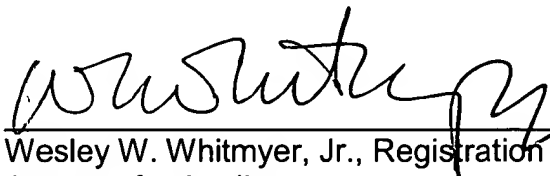
Mailing Certificate: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as *First Class Mail* in an envelope addressed to: Commissioner for Patents; P.O. Box 1450; Alexandria, VA 22313-1450.

August 26, 2004

Tamara L. Millikan
Tamara L. Millikan

1. **Listing of Foreign Countries Where Filed (37 CFR 5.25(a)).** The unlicensed patent application material was filed in Germany as two German national patent applications and as a PCT application. Although the PCT application designated numerous countries, to the best of the undersigned's knowledge national stage was entered in the United States only.
2. **Dates of Filing in Each Foreign Country (37 CFR 5.25(b)).** The German national patent applications were filed on November 20, 1995 and on March 16, 1996. The PCT application was filed on November 20, 1996.
3. **Verified Statement (37 CFR 5.25(c)).** The requisite verified statement is attached hereto.
4. **Petition Fee (37 CFR 5.25(d)).** Enclosed herewith is a check in the amount of \$130.00 in accordance with 37 CFR 1.17(h), as required by 37 CFR 5.25(d). The undersigned hereby requests that any additional fee which is due be charged to Account Number 19-4516.

Respectfully submitted,



Wesley W. Whitmyer, Jr., Registration No. 33,558
Attorney for Applicant
ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155

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**DECLARATION OF FACTS IN SUPPORT OF PETITION
FOR RETROACTIVE FOREIGN FILING LICENSE UNDER 37 C.F.R. 5.25**

Dear Sir:

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I, Wesley W. Whitmyer, hereby declare and state as follows:

1. I am an attorney of record in connection with the above-captioned patent and was responsible for prosecution thereof.
2. The subject matter of the above-captioned patent was not under a secrecy order at the time it was filed abroad, and is not currently under a secrecy order.
3. Storz Endoskop GmbH (hereinafter "Storz"), the assignee of the patent in question, is a multinational company, based in Switzerland. It has facilities in many countries throughout the world, including Switzerland, Germany and the United States. It is the practice of Storz to first file patent applications directed to inventions by employees thereof in the country where the invention was made, and then to later file applications as it deems appropriate in various additional countries.

4. In the present case, there were three inventors of the subject matter to which the patent in question is directed, one located in Switzerland, one located in Germany and one located in the United States. In or around November of 1995, when the first patent application was filed in Germany, Storz identified Germany as the country where the invention had been made, and filed first one and then a second national patent application in Germany. The filing of these applications was followed by the filing of a PCT application (also in Germany), upon which the application in question was based.

5. It has recently come to my attention through conversations with Storz personnel that the invention was more likely made in the United States than in Germany, and that the foreign filings in Germany were proscribed since no foreign filing license was obtained. I diligently filed the present petition seeking a retroactive foreign filing license after this discovery.

6. The unlicensed patent application material was filed abroad through error and without deceptive intent because of the erroneous identification of Germany as the country where the invention had been made.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued there on.

18 AUG 2004
Date

Wesley W. Whitmyer, Jr.
Wesley W. Whitmyer, Jr.

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